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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte AARON GOLLE
and JOHN GOLLE

Appeal 2009-002874
Application 10/707,618
Technology Center 2800

Decided:¹ June 24, 2009

Before PETER F. KRATZ, CATHERINE Q. TIMM, and
KAREN M. HASTINGS, *Administrative Patent Judges*.

TIMM, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the Decided Date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's decision rejecting claims 1, 3, 4, 10-12, 15, and 16. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

I. STATEMENT OF THE CASE

The invention relates to a safety sign utilizing an electroluminescent (EL) light element having a blue-green illuminated color and a white non-illuminated color. The sign further includes a yellow tint layer in order to obtain a yellow color in a non-illuminated daytime operating condition and a light green color in an illuminated condition. (Spec. ¶¶ 1, 28, 29, and 34).

Claim 1 is illustrative of the subject matter on appeal:

1. An EL sign for use on a vehicle comprising an EL illuminated color and a non-illuminated color, and further including an EL lighting element that is white in a non-illuminated condition and blue-green in an illuminated condition, and a yellow layer that imparts a yellow tint to the sign in daylight when the EL lighting element is non-illuminated and a light green appearance at night when the EL lighting element is illuminated.

Appellants request review of the sole rejection maintained by the Examiner, namely, the rejection of claims 1, 3, 4, 10-12, 15, and 16 under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 5,533,289, issued July 9, 1996, to Hoffman (hereinafter "Hoffman").

Appellants' arguments are directed to claim 1 (Br. 10-11). Since no other pending claim is separately mentioned, we select claim 1 as the representative claim. See 37 C.F.R. § 41.37(c)(1)(vii).

II. ISSUE ON APPEAL

The sole issue on appeal arising from the contentions of Appellants and the Examiner is: have Appellants shown that the Examiner reversibly

erred in determining that the invention recited in claim 1 would have been obvious to one of ordinary skill in the art having the teachings of Hoffman?

III. FACTUAL FINDINGS

The following Findings of Fact (FF) are relevant to deciding the issue on appeal:

1. Appellants' Specification states:

[s]elected embodiments of safety signs as described in this document include colored EL material. Both an illuminated color and a non-illuminated color may be selected. Possible colors include yellow, white, blue-green, etc. A color can be chosen in the non-illuminated condition that is suited for daytime, while a different color can be chosen for the illuminated condition to optimize both day and night. The addition in safety sign 500 of a layer 530 further broadens color options. In one embodiment, the layer 530 is tinted to alter the color of the EL lighting surface. In one embodiment, an EL lighting surface is included that is white in a non-illuminated condition, and blue-green in an illuminated condition. In one embodiment, a yellow tinted layer 530 is further included. This provides a yellow appearance in the day, with a light green appearance at night. In one embodiment, the light green complies with government regulations for color. In another embodiment, an EL lighting surface is included that is yellow in a non-illuminated condition, and yellow in an illuminated condition. In one embodiment, a yellow tinted layer 530 is further included. This provides a yellow appearance in the day, and a yellow appearance at night.

(Spec. ¶ 34).

2. Appellants' Specification also states that "[o]ne good example of EL lighting can be obtained from the Durel Corporation of Chandler, AZ" (Spec. ¶ 29).
3. Hoffman teaches an EL sign and that "[o]ne or more contrast layers or sheets of translucent colored or contrast material can be disposed over at least part of the visible portion of the lamp for enhanced visual effect" (Hoffman, col. 2, ll. 29-32; *see also* col. 4, ll. 28-30).
4. Hoffman also teaches a preferred electroluminescent lamp 12 is the Durel 3 lamp, which is also available from the Durel Corporation (Hoffman, col. 3, ll. 8-9).

IV. PRINCIPLES OF LAW

"Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007) (*citing* 35 U.S.C. § 103).

"The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR*, 550 U.S. at 416. The question to be asked is "whether the improvement is more than the predictable use of prior art elements according to their established functions." *Id.* at 417. "When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp." *Id.* at 402. If

this leads to the anticipated success, it is likely the product not of innovation, but of ordinary skill and common sense. *Id.*

A reference “teaches away” when an artisan upon reading it would be discouraged from following the path set out in the reference or would be led in a direction divergent from the path that was taken by the applicant. *See In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994). As an example, a reference may teach away from a use when that use would render the result inoperable. *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1354 (Fed. Cir. 2001); *see also In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004) (explaining that there is no teaching away when the “disclosure does not criticize, discredit, or otherwise discourage the solution claimed”).

V. ANALYSIS

Appellants contend that Hoffman fails to teach all the elements of the claimed subject matter, and that Hoffman actually teaches away from the claimed subject matter (Br. 10). Specifically, Appellants contend that Hoffman fails to teach a sign having a first desired color during the daylight in a non-illuminated condition and a second color during the evening in an illuminated condition (Br. 10). Additionally, according to Appellants, Hoffman is silent as to the particular color combination claimed, i.e., the yellow tint during the day and light green appearance at night (Br. 10-11). It is Appellants’ position that Hoffman is instead focused on the use of stencils to provide indicia on a sign at low cost, and that Hoffman teaches away from Appellants’ invention because Appellants’ invention has nothing to do with stenciling (Br. 11).

The Examiner finds that Hoffman teaches an EL lighted sign having an EL illuminated color and a non-illuminated color (Ans. 6). The Examiner

finds that “[t]he sign would be a first desired color in a non-illuminated condition (via a particular contrast layer and indicia) and a second different color when illuminated (via different contrast layers in combination along with the indicia).” (Ans. 6.) According to the Examiner, “signs are commonly known in the art to have two or more colors (e.g., yellow, white, and blue-green)” and this is corroborated by Hoffman (Ans. 3 and 7). The Examiner also explains that “Hoffman is not necessarily focused on the use of stencils” and “Appellant is [sic, Appellants are] unnecessarily restricting Hoffman to teach a stencil” (Ans. 5-6).

Appellants’ Specification indicates that the EL lighting element may be commercially obtained from the Durel Corporation of Chandler, AZ, which is also the preferred supplier for the electrolumination lamp 12 taught by Hoffman (FF 3-4). Accordingly, the selection of a known lighting element according to its established function would have been well within the knowledge and skill of the ordinary artisan. The selection of a particular lighting element, such as those commercially available from the Durel Corporation, as evidenced by the teachings of Hoffman (FF 4), would have been within the technical grasp of the ordinary artisan.

We agree with the Examiner that the selection of yellow and light green would have been obvious to one of ordinary skill in the art (Ans. 7-8) in order to obtain the color dictated by government regulation (Br. 10; FF 2). We also agree with the Examiner that combining blue-green and yellow to make light green is no more than conventional color mixing (Ans. 7-8) and well within the technical grasp and thus obvious to one of ordinary skill in the art.

We further note that Appellants' arguments are only directed to "a sign" having different colors in an illuminated and non-illuminated condition (Br. 10). Since Hoffman teaches the use of more than one colored layer (FF 3), we agree with the Examiner that the evidence establishes that it would have been obvious to one of ordinary skill in the art to use two colored layers to provide different colors to a sign in an illuminated and non-illuminated condition.

Appellants have presented no reasoning to conclude that the teachings of Hoffman would have discouraged one of ordinary skill in the art from using the contrast layers as noted by the Examiner, nor would the use of a stencil render the use of different colored contrast layers inoperable. Accordingly, using stencils as indicia does not teach away from the claimed invention.

Accordingly, Appellants have not shown that the Examiner reversibly erred in determining that the invention recited in claim 1 would have been obvious to one of ordinary skill in the art having the teachings of Hoffman.

Appellants indicate that claims 3, 4, 10-12, 15, and 16 "are believed to be allowable at least for the same reasons provided with respect to [claim 1]" (Br. 11). Thus, Appellants also have not shown that the Examiner erred in rejecting any of claims 3, 4, 10-12, 15, and 16 as being obvious over Hoffman.

VI. CONCLUSION

For the reasons discussed above, we sustain the Examiner's rejection of claims 1, 3, 4, 10-12, 15, and 16 under 35 U.S.C. § 103(a) as being obvious over Hoffman.

VII. DECISION

We affirm the Examiner's decision.

VIII. TIME PERIOD FOR RESPONSE

No time period for taking any subsequent action in connection with this appeal maybe extended under 37 C.F.R. § 1.136(a)(1)(v) (2008).

AFFIRMED

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